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No. 113

In the

Supreme Court of the United States

OCTOBER TERM, 1955

JEOFFROY MFG., INC.,
Petitioner,

v.

WILLIAM T. GRAHAM,
Respondent.

PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

W. W. GIBSON and
S. TOM MORRIS,
630 Amarillo Building,
Amarillo, Texas,
Attorneys for Petitioner.

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To the United States Supreme Court:

Petitioner, JEOFFROY MFG., INC., respectfully prays for a rehearing and reversal of the order entered on October 10, 1955, denying its petition for writ of certiorari to the United States Court of Appeals for the Fifth Circuit, and as grounds therefor shows the following:

1. Intervening Circumstances of Substantial Effect

By way of review—the patent in suit, No. 2,627,798, covers an improved spring clamp for a plow. The District

Court found as a matter of fact that the improvements covered by the patent were "well within the capacity of a skilled mechanic" (R. 31), and held the patent void for lack of invention. The Court of Appeals overturned the trial court's finding, concluding that the

> "* * * hybrid type structure combining the wear-resisting rotating pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old * * * structure, reveals sufficient indicia of novelty and invention to justify limited protection"

and reversed the judgment.

In the petition for certiorari we urged that the Court of Appeals completely disregarded Rule 52(a) of the Federal Rules of Civil Procedure requiring that:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

The Court of Appeals did not expressly state that it was disregarding Rule 52(a), but that it did so is obvious upon the face of the opinion. It can only be concluded from the opinion that the Court of Appeals considered the questions of novelty and invention as questions of law, fully reviewable by it de novo upon the record without regard to the trial court's findings of fact.

Our interpretation of the opinion is fully borne out by a subsequent decision of the Fifth Circuit to which we now

direct the Court's attention as an intervening circumstance of substantial effect. On July 15, 1955, some forty-five days after the Petition for writ of certiorari was filed herein, the Court of Appeals handed down its decision in *Fritz W. Glitsch & Sons v. Wyatt Metal & Boiler Works, 224 F. 2d 331*, in which the Court said at page 335:

> "* * * while infringement is usually a question of fact, on which the normal presumption of verity might attach to the findings of the trial court under Rule 52 (a), F. R. C. P., the issue of whether a particular patent meets the requisite standard of invention essential to validity is now generally regarded as a fully reviewable question of law * * *."

The Court then proceeded to determine the question of invention de novo upon the record without regard to or discussion of the trial court's findings.

We express no opinion as to the *result* of the *Glitsch* case. Our point is that the Fifth Circuit has now made it absolutely clear that it considers Rule 52(a) wholly inapplicable to the review of the trial court's findings upon invention, and the conclusion is inescapable that its rulings in the case at bar were guided and controlled by that view of the law.

It is thus clear beyond any question that the case at bar is in direct conflict with *Graver Tank & Mfg. Co. v. Linde Air Prod. Co., 336 U. S. 271 (1949)*, wherein the Court said that in no type of case is it more appropriate to give due regard to the trial court's opportunity to judge credi-

bility of the witnesses than in a patent case, and at page 279 that:

> "The same deference is due to the findings of the trial court which overturn claims as to those which sustain them. Technicians may and probably will continue to debate with plausible arguments on each side as to what this obscure process really is. But the record in this case, while not establishing to a certainty that the findings are right, fall far short of convincing us that they are clearly erroneous. We think that the rules that govern review entitle the trial court's conclusions to prevail and that the process claims are invalid under the statute."

The *Graver Tank* decision has not been in any manner disturbed by *Great A & P Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147 (1950)*, and if the Court meant what it said in the *Graver Tank* case then the Fifth Circuit decision in the case at bar is clearly wrong.

It may be agreed that the ultimate question of patentability, including the question of whether an appropriate standard was applied, is one of law fully reviewable by the appellate courts, but that does not mean, as the Fifth Circuit seems to think, that Rule 52(a) is wholly inapplicable where the question of invention is involved. In the case at bar the trial court made a pure finding of fact that the improvements covered by the patent were "well within the capacity of a skilled mechanic." The Fifth Circuit did not hold or even intimate that the trial court applied an inappropriate standard; it merely disagreed with the trial court's finding and thereupon reversed the decision.

It is thus apparent that the Court of Appeals applied an erroneous rule of law as to the scope of review, and a question of law is clearly presented which calls for review by this Court.

II. Substantial Grounds not Previously Presented

The decision of the Court of Appeals is in conflict with the decision of this Court in *Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545 (1938); General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364 (1938); United Carbon Co. v. Binney & Smith Co., 317 U. S. 228 (1942);* and *Great A & P Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147 (1950);* for a reason not heretofore presented to this Court.

The cited cases hold that invention which is not particularly pointed out and distinctly claimed in the patent cannot support the patent, yet the Court of Appeals has here sustained the patent by finding invention which was not pointed out, claimed, otherwise disclosed or even hinted at in the patent. The Court of Appeals said *(219 F. 2d 518,* and at page 16 of the appendix to our petition for certiorari):

> "Though we do agree that 798 (Patent No. 2,627,798), as an improvement combination, is not entitled to any broad degree of protection over 811 (Patent No. 2,493,811), it still seems to us that its hybrid type of structure combining the wear-resisting rotating pivot, in part reminescent of the prior art, with the new shank and stirrup arrangement permitting some of the same advantageous flexibility inherent in the old

> 811 structure, reveals sufficient indicia of novelty and invention to justify limited protection."

This theory of invention upon which the Court of Appeals has lodged is not mentioned or claimed in any respect in the patent. It is the mere afterthought contention of patentee's counsel which the Court of Appeals has accepted as sufficient to support the patent.

A holding of patentability upon supposed invention not disclosed or claimed in the patent was squarely condemned by this Court in the *A & P* case, *340 U. S. at 149*, as follows:

> "Since the Courts below perceive invention only in an extension of the counter, we must first determine whether they were right in so doing. We think not. *In the first place, the extension is not mentioned in the claims*, except, perhaps, by a construction too strained to be consistent with the clarity required of claims which define the boundary of a patent monopoly." (Italics supplied.)

A similar attempt to support a patent upon a theory of invention not pointed out or claimed in the patent was equally disapproved in the *Lincoln Engineering* case, *303 U. S. at 549*, as follows:

> "* * * the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in a new combination. Though the respondent so concedes, it urges that, in the combination of the Butler patent, the headed nipple performs a new and different function from that which it has heretofore performed, in other combinations, in that, when

> the coupler is withdrawn from the nipple, at the end of the greasing operation, the round head of the nipple 'cocks' the jaws of the coupler for the next operation. *The sugges ion seems to be an afterthought. No such function of the nipple is hinted at in the specifications of the patent.* If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted." (Italics supplied.)

In the patent in suit there is no hint of a hybrid type structure combining the rotating pivot of the prior art to reduce wear with a stirrup and shank arrangement *to retain some of the desirable flexibility* of the old Graham 811 structure. On the contrary, the specifications speak of a shank *rigidly secured* to a shank attaching member and the claims call for a shank in *constant and continuous* contact with a shank attaching member. ~~But~~ thus, even assuming that the Court of Appeals was correct in concluding that there was invention (a matter which we have pointed out in our petition for certiorari as being based on an erroneous standard of "old result in a cheaper and otherwise more advantageous way"), such invention clearly cannot support the patent because it was not pointed out or claimed therein.

It seems clear to us that the Fifth Circuit has sustained the patent on grounds squarely in conflict with decisions of this Court and for this reason also writ of certiorari should be granted.

III. Importance of the Case

It is inconceivable that this Court could have denied the petition for writ of certiorari on the ground that no ques-

tion is presented appropriate for its review. It must be that the Court considers the matter too trivial to take a place on the docket, and we, therefore, earnestly urge that the Court reconsider the importance of the case in the light of the following additional circumstances.

We recognize that the decision will not touch the lives of all citizens as would a segregation, anti-trust, or tidelands decision, but, even so, there is much more at stake here than the mere final result to these litigants. The erroneous rules and concepts under which the Fifth Circuit is deciding patent cases affect every person who must have his rights or liabilities under any patent adjudicated in this Circuit, and with the rapidly expanding industrialization of the Southwest the number of such persons is daily increasing by leaps and bounds. Furthermore the whole public is affected by every patent monopoly that is either sustained or struck down. There is also another aspect of considerable importance. The pro-patent attitude of the Fifth Circuit is so well known that it is breeding patent litigation here which would otherwise go elsewhere or not be filed at all. For instance, there is now pending in the United States District Court for the Northern District of Texas, Amarillo Division, another suit, No. 1953, styled *William T. Graham, et al. v. Cockshutt Farm Equipment, Inc.*, under this same patent against a defendant whose main office is in Ohio, and who has only a dealer in this district. Another example is No. 1992 in the same Court, styled *Carl A. Hillgren v. Amarillo Lumber Company, Inc., et al.*, wherein a California patentee, whose patent

has been struck down by the Ninth Circuit in *Kwikset Locks v. Hillgren, 210 F. 2d 483 (1954)*, is suing a Texas retailer on a lock made by an Illinois manufacturer. One may wonder why the suit was not brought directly against the manufacturer in Illinois, and the quick and ready answer would seem to be that the patentee hopes to obtain a decision of validity in the pro-patent Fifth Circuit contrary to that of the Ninth Circuit, and thus advance to the Supreme Court.

These considerations strongly indicate that this Court should grant a rehearing and upon rehearing grant a writ of certiorari not only to correct an erroneous result between these litigants but also to correct the erroneous rules and concepts prevailing in the Fifth Circuit.

WHEREFORE, Jeoffroy Mfg., Inc., prays that this petition for rehearing be granted and that upon further rehearing it have relief as prayed for in the original petition for writ of certiorari.

Respectfully submitted,

W. W. GIBSON and
S. TOM MORRIS,
630 Amarillo Building,
Amarillo, Texas,
Attorneys for Petitioner.

By W. W. GIBSON

CERTIFICATE OF COUNSEL

I hereby certify that this petition for rehearing is presented in good faith and not for delay, that it is limited to the grounds above specified as provided by Rule 58 (2) of the Rules of the Supreme Court, and that copies of this petition have been delivered in person to Clayton Heare, Amarillo Building, Amarillo, Texas, and sent by United States Mail, postage prepaid, to Claude A. Fishburn and Orville O. Gold, 1217 Commerce Trust Building, Kansas City, Missouri, attorneys for Respondents.

DATED: October 31, 1955.

W. W. GIBSON

Attorney for Petitioner.